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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,132	01/18/2001	Thaddeus I. Kingsford	58091-A CCD	7826

7590

12/17/2003

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New York, NY 10036

EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 12/17/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,132

Applicant(s)

KINGSFORD ET AL.

Examiner

David Comstock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,9,10,18-21,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,29 and 30 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12. 6) ☐ Other: _____

DETAILED ACTION

Inventorship

In view of the papers filed 10 February 2003, the inventorship in this nonprovisional application has been changed by the deletion of Michael M. Malvar and Volker Schrepf. The sole remaining inventor of record is Thaddeus I. Kingsford.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarica (4,726,387).

Sarica discloses a cosmetic device comprising a manipulable applicator unit 2 including an applicator brush 3 and a material container unit, a receptacle 8 for a coherent body of material, and a cover 1A (see Fig. 1). A well 9 opens through the proximal end of the unit. The applicator is removably inserted into the well. The container unit includes a housing member 1B having a receptacle therein and a lateral

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opening in the side facing the cover. The receptacle is disposed distally of the well and opens laterally of the unit. The cover is manually movable relative to the receptacle. The well is positioned such that the applicator and the well are disposed in tandem along a long axis of the container unit. The handle of the applicator projects from the well when the applicator is positioned in the well. The container unit may contain "all types of cosmetics" which necessarily includes lip colorant (emphasis added, see col. 2, lines 23-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarica (4,726,387).

Sarica discloses the claimed invention except for the cover being formed of transparent material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the cover of transparent material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarica (4,726,387) in view of Giese et al. (5,655,553).

Sarica discloses the claimed invention except for the removable pan and the aperture in the receptacle. Giese et al. disclose a cosmetics compact 10 having a pan and apertures 52 in the receptacle 50 to allow pressure to be applied to the bottom of the pan through the holes in the receptacle to allow the pans to be removed and replaced without complication and to improve the convenience of the device (see Fig. 2; col. 1, lines 9-13 and 45-49; and col. 2, lines 1-5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the compact of Sarica with a removable pan and an aperture in the receptacle, in view of Giese et al., in order to allow pressure to be applied to the bottom of the pan through the hole in the receptacle to allow the pan to be removed and replaced without complication and to improve the convenience of the device.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarica (4,726,387) in view of Giese et al. (5,655,553) as applied to claim 19 above, and further in view of Ebbetts, III et al. (5,437,294).

The device of the combination of Sarica in view of Giese et al. discloses the claimed invention except for the pan being divided into a plurality of laterally opening compartments. Ebbetts, III et al. disclose a compact 10 having a pan divided into a plurality of laterally opening compartments 18 to allow cosmetics of different colors to be housed therein and improve the versatility of the device (see Fig. 3 and col. 4, lines 20-27). It would have been obvious to one having ordinary skill in the art at the time the

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invention was made to provide the compact of Sarica and Giese et al. with a pan divided into a plurality of laterally opening compartments, in view of Ebbetts, III et al., in order to allow cosmetics of different colors to be housed therein and improve the versatility of the device.

Allowable Subject Matter

Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment—making the applicator in the well and the receptacle in tandem along a long axis of the container—necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

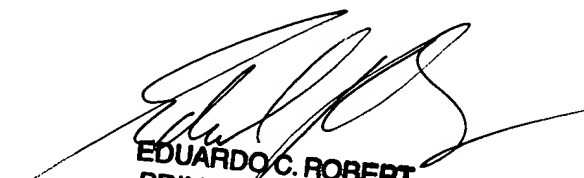
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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D.C. Comstock
11 December 2003



EDUARDO C. ROBERT
PRIMARY EXAMINER